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09/769,149	01/25/2001	Spencer A. Rathus	660-027	8433

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Ward & Olivo
382 Springfield Avenue
Summit, NJ 07901

EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,149

Applicant(s)

RATHUS ET AL.

Examiner

Ahshik Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 168-263 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 168-263 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s) _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on April 16, 2003. In the amendment,
5 claims 169, 183, 194, 251-258, 260, 261, and 263 were amended. Currently, claims 168-263
remain for examination.

Claim Objections

2. Claim 168 is objected to because of the following informalities:
10 Re claim 168, line 3: substitute "stationary" with --stationery--.
- Examiner listed only claim 168, however, the Applicant is required to substitute all
occurrences of "stationary" in the claims and all other parts of the application.
- Appropriate correction is required.

Claim Rejections - 35 USC § 103

15 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

- 20 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
manner in which the invention was made.

- This application currently names joint inventors. In considering patentability of the
25 claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various
claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

- 5 3. Claims 168-173, 176-178, 195-196, 220, 229-232, 237-239, 242, 253, 258, and 260-263 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al. (US 4,488,035, "Withnall" hereinafter) in view of Fields (US 4,481,412).

Re claims 168-173, 176-178, 195-196, 220, 229-232, 237-239, 242, 253, 258, and 260-263: Withnall discloses a system for displaying information to a user comprising a printed
10 stationary having at least one machine recognizable feature (i.e., barcode); a feature recognition unit 18 having associated therewith a means for recognizing the machine recognizable feature (col. 4, lines 2-30); display the information on the portable handset illuminated display having a microprocessor with programmable memories (col. 5, lines 10-17).

Withnall fails to teach or fairly suggest that the displayed information is programming
15 material and the system further comprising means for transmitting a coded signal in response to the recognition of the machine recognizable feature and an intelligent controller having associated therewith a means for accessing the programming material in response to receiving the coded signal.

Fields teaches the above limitation with an accessing means 10 having a microcontroller
20 23 including a barcode electronic circuit 25 electrically coupled to the barcode reader 24 for transmitting/accessing the programming material in response to receiving the coded signal (fig. 2; col. 7, line 40 through col. 8, line 11); wherein the displayed data is a video/

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image/programming/sound/pictorial/electronic/media data and wherein the display 22 is a television/workbook (col. 6, lines 56-64 and col. 8, line 12 through col. 9, line 55).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Fields into the teachings of Withnall in order to provide the user with flexibility in viewing his/her desired/requested information (i.e., video, pictorial, etc.), and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall, and therefore an obvious expedient.

4. Claims 174, 175, 180, 181, 183, 189, 190, 192, 193, 214-219, and 222-223 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields as applied to claim 168 above, and further in view of Roberts (US 5,324,922) and Malec et al. (US 5,287,266, "Malec" hereinafter). The teachings of Withnall as modified by Fields have been discussed above.

Re claims 174, 175, 180, 181, 183, 189, 190, 192, 193, 214-219, and 222-223:

Withnall/Fields have been discussed above but fails to teach or fairly suggest feature for online/home shopping band the data link comprises a cable television line.

Roberts teaches the above limitation with a home/online shopping system (figs. 1-14; col. 1, lines 58+; col. 7, line 35 through col. 12, line 35).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roberts into the teachings of Withnall/Fields with a faster Internet access system due to the benefit of cable television transmitting/conducting communication capability. Furthermore, such modification would have been an obvious

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extension as taught by Withnall/Fields to provide the user with an alternative way of conducting the shopping at his/her convenience (i.e., online shopping /at home), and therefore an obvious expedient.

Withnall/Fields as modified by Roberts fails to teach or fairly suggest that the data link
5 comprises an ISDN line.

Malec teaches the above limitation with the use of ISDN technology (col. 7, lines 112).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Malec into the teachings of Withnall/Fields/Roberts in order to provide Withnall/Fields/Roberts with the latest technology
10 for a more accurate and faster system due to the benefit of ISDN networking lines. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Roberts and would have been merely a substitution of equivalents (i.e., to cable television line) well within the ordinary skill in the art, and therefore an obvious expedient.

5. Claims 179, 182, 184, 186-188, 191, 194, 199-201, 203-204, 209-210, 213, 221, 224,
15 225-226, 227-228, 236, 241, 243-245, 256, and 259 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields as applied to claims 168 and 258 above, and further in view of Bravman et al. (US 5,401,944, "Bravman" hereinafter). The teachings of Withnall as modified by Fields have been discussed above.

Re claims 179, 182, 184, 186-188, 191, 194, 199-201, 203-204, 209-210, 213, 221, 224,
20 225-228, 236, 241, 243-245, 256, and 259: Withnall/Fields have been discussed above but fails to teach or fairly suggest that the display unit comprising a wireless communication device (e.g., a remote unit).

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Bravman teaches the above limitation with remote units 15 providing all necessary information related to traveling (i.e., seat assignment; airline/hotel/rental cars reservations, etc.) in col. 4, line 21 through col. 14, line 5 and col. 16, line 14 through col. 18, line 22.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bravman into the teachings of Withnall/Fields in order to provide Withnall/Fields with the latest technology system (i.e., a wireless communication device) and a more compact system wherein the portable handheld communication device can be carried along with the user without causing any inconvenience, and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields, and therefore an obvious expedient.

6. Claims 197, 202, and 205 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields as applied to claim 168 above, and further in view of Anmelder (DT 2,452,202 A1). The teachings of Withnall as modified by Fields have been discussed above.

Re claims 197, 202, and 205, Withnall/Fields have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature is invisible.

Anmelder teaches the above limitation with the machine recognizable feature is invisible (see English abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Anmelder into the teachings of Withnall/Fields in order to provide Withnall/Fields with an improved security system wherein the data recorded in the machine recognizable feature is invisible to the naked eye, and thus preventing an unauthorized individual(s) from manipulating the data. Furthermore, such

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modification would have been an obvious extension as taught by Withnall/Fields, and therefore an obvious expedient.

7. Claims 198 and 212 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields as applied to claim 168 above, and further in view of Tannehill et al. (US 5,158,310, "Tannehill" hereinafter). The teachings of Withnall as modified by Fields have been discussed above.

Re claims 198 and 212, Withnall/Fields have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature comprises a magnetic code/strip. Tannehill teaches the above limitation with the machine recognizable feature can be a barcode or a magnetic strip (col. 18, lines 7-12).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Tannehill into the teachings of Withnall/Fields in order to provide Withnall/Fields with an alternative feature for encoding data (i.e., magnetic strip versa barcode), which can be read a convention magnetic strip reader. Furthermore, such modification would have been merely a substitution of equivalents for storing data well within the ordinary skill in the art, and therefore an obvious expedient.

8. Claims 206-208 and 211 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields as applied to claim 168 above, and further in view of Schach et al. (US 5,397,156, "Schach" hereinafter) and Anmelder (DT 2,452,202 A1). The teachings of Withnall as modified by Fields have been discussed above.

Re claims 206-208 and 211, Withnall/Fields have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature comprises a watermark.

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Schach teaches the above limitation with a machine recognizable feature 42 comprises a watermark (see abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Schach into the teachings of Withnall/Fields
5 for its aesthetic purposes. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields, and therefore an obvious expedient.

Withnall/Fields as modified by Schach et al fails to teach or fairly suggest that at least one machine recognizable feature comprises an invisible watermark.

Anmelder teaches the above limitation with the machine recognizable feature is invisible
10 (see English abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Anmelder into the teachings of Withnall/Fields/Schach et al in order to provide Withnall/Fields/Schach et al with an improved security system wherein the data recorded in the machine recognizable feature is invisible to the
15 naked eye, and thus preventing an unauthorized individual(s) from manipulating the data.

Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Schach, and therefore an obvious expedient.

9. Claims 185, 233-235, 240, 241, 246-252, 254, 255, and 257 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields as applied to claims 168 and
20 258 above, and further in view of Morales (US 5,872,589). The teachings of Withnall as modified by Fields have been discussed above.

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Re claims 185, 233-235, 240, 241, 246-252, 254, 255, and 257: Withnall/Fields have been discussed above but fails to teach or fairly suggest that the display unit comprises a personal planner/phone/pager.

Morales teaches the above limitation in figs. 2, 5, 8 & 9; col. 3, lines 28 through col. 7,

5 line 12).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Morales into the teachings of Withnall/Fields in order to provide the user with the flexibility of selecting his/her desired display unit that is more convenient to his/her needs, thus providing a more user-friendly system. Furthermore, such
10 modification would have been an obvious extension as taught by Withnall/Fields, and therefore an obvious expedient.

Response to Arguments

15 10. Applicants' amendment and remarks filed on April 16, 2003 have been given careful consideration, but they are not persuasive in view of the rejection stated above.

With respect to the rejection under 35 U.S.C. 103(a), Applicant argues (See page 15, 1st paragraph thereafter) essentially that the cited references in combination fail to specifically teach or fairly suggest the subject matter disclosed in instant application.

20 Although Applicants' embodiment may be different from disclosures shown in these references, it is Examiner's opinion that the cited references, in combination, teach the claimed invention of instant application. For example, claim 168 recites "A system for displaying programming material to a user, the system comprising: printed stationary having at least one

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machine recognizable feature; a feature recognition unit having associated therewith a means for recognizing said machine recognizable features and a means for transmitting a coded signal in response to the recognition of said machine recognizable feature; an intelligent controller having associated therewith a means for accessing said programming material in response to receiving
5 said coded signal; and a display unit for presenting said programming material.” Other independent claims 258 and 261 recite similar methods (although scope of claim 258 seems broader than claim 261).

The Withnall patent discloses a printed matter having one machine recognizable feature such as barcode; a feature recognition unit; and a portable handset displaying information to the
10 users. Without borrowing the subject matter disclosed in the Fields patent, it is Examiner’s view that travel information which can be retrieved once barcode on the ticket has been read can be considered programming material (see Withnall, col. 5, lines 14+) associated with the barcode. Applicant might argue that a ticket may not be a stationary as recited in the claims presented in the instant application. Merriam-Webster’s College Dictionary (10th edition) defines stationery
15 as “materials (as paper, pens, and ink) for writing or typing”. Accordingly, a ticket disclosed in Withnall is a paper product on which information can be written or printed.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,
20 suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

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1992). In this case, the primary reference to Withnall and the secondary references to Fields and Nobles are directed to a printed matter (i.e., tickets, textbooks, etc.) comprising an indicia, which is used for programming and further processing. Accordingly, it is Examiner's view that the motivations, which are within one ordinary skill in the art, to improve the primary reference to

5 Withnall have been provided.

Although double patenting rejection has been overcome by filing of terminal disclaimer (Paper #8), the claims are broadly recited such that the cited references, taken alone or in combination, teach the claimed invention.

Applicants' amendment and remarks describing these elements have been carefully
10 studied and considered, but they are not persuasive. Therefore, Examiner has made this Office Action final.

Conclusion

15 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after
20 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.


Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Patent Examiner
Art Unit 2876
August 13, 2003



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